RESPONSE AND REMARKS

CLAIM REJECTIONS UNDER SECTION 103(a)

In the Office Action, Claims 1-10, 19-21, 60-65 and 100-102 were rejected under 35 U.S.C. §103(a) as being unpatentable over Schwab et al. (U.S. Patent Application Publication No. U.S. 2002/0019777; "*Schwab*") in view of Siegel (U.S. Patent Application Publication No. U.S. 2004/0143519; "*Siegel*") and Junger (U.S. Patent No. 6,269,344, "*Junger*"). *Office Action*, Topic Nos. 2-7, pgs. 2-4.

Claims 10-12, 27, 62-65, 103, and 138-141 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwab*, *Siegel* and *Junger* and further in view of Kara (U.S. Patent No. 6,233,568; "*Kara*"). *Office Action*, Topic Nos. 8-10, pgs. 4-5.

Claims 13-21, 27, and 65 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwab*, *Siegel*, *Junger* and *Kara* as applied to Claim 11 above, and further in view of UPS® Service Guide (www.ups.com) ("*UPS*"), FedEx® Services (www.fedex.com) ("*FedEx*") and Barnett et al. (U.S. Patent No. 6,369,840; "*Barnett*"). *Office Action*, Topic Nos. 11-14, pgs. 5-6.

RESPONSE REMARKS REGARDING CLAIM REJECTIONS UNDER SECTION 103(a)

The rejections of the Claims have been carefully considered. Claims 1, 10-12, and 100 have been amended to more distinctly claim the claimed invention.

A Display to a Consumer of Carriers Selected by a Merchant for Use by the Consumer for a Shipment to the Merchant of a Returnable Item is Patentably Distinct From the References of Record

It is respectfully submitted that the rejections fail to identify any reference or combination of references that disclose the limitations claimed in one way or another by independent Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display, to a consumer of carriers that have been selected by a merchant for use by the consumer in shipping a return of an item of merchandise that the consumer had purchased from the merchant.

For example, amended independent Claim 1 recites a merchant-selected display of carriers to a consumer as follows:

> if the particular respective item of merchandise is returnable, generate a display to the consumer comprising information corresponding to a set of carriers selected by the particular online merchant for use by the consumer for a return shipping of the particular respective item of merchandise to the particular online merchant.

Independent Claim 27 similarly recites a merchant-selected display of carriers to a consumer as follows:

> wherein the set of carriers and the set of services are selected by the computer system for display according to a set of return policy rules input by the merchant, and wherein each respective shipping rate is calculated by the computer system according to information about the at least one item of merchandise that is accessible by the computer system

Similarly, independent Claim 62 recites a merchant-selected display of carriers to a consumer as follows:

> collecting a set of return policy rules input by a merchant comprising an identification by the merchant of a set of carriers that may be used by a consumer for shipping an item of merchandise; …and
> in response to [a] merchandise return request, generating a display to the consumer of the set of carriers identified by the merchant according to the return policy rules for use by the consumer for shipping the particular item of merchandise to the merchant.

It is further respectfully submitted that, In one way or another, independent Claims 65, 100, 103, 138 and 141 similarly recite a merchant-selected display of carriers to a consumer.

It is respectfully asserted that the Office Action fails to identify any reference or combination of references that disclose, anticipate, teach of suggest the above-described limitations claimed in one way or another by independent Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display, to a consumer of carriers [and services] that have been pre-selected by a merchant for subsequent use by the consumer in shipping a return of an item of merchandise that the consumer had purchased from the merchant.

In rejecting Claim 27 which, previous to the present amendments, claimed "...wherein the set of carriers and the set of services are selected by the computer system for display according to a set of return policy rules input by the merchant ...", the Office Action asserted *Schwab* in combination with *Siegel*, *Junger* and *Kara*. *Office Action*, Topic No. 8, p.4. The Office Action conceded that *Schwab* "... fails to disclose[] selecting a carrier for shipment and calculating the shipping rate for the return." *Office Action*, Topic No. 9, p.4.

However, in order to compensate for the conceded failure of *Schwab*, the Office Action posits that *Kara* "... discloses the use of a system used to select a carrier for shipment and calculating shipping rates for a plurality of carriers ...." *Office Action*, Topic No. 9, p.4. The Office Action then concluded that "[i]t would have been obvious ... to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers, according to Kara, in order ... for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract)." *Office Action*, Topic No. 9, pgs. 4-5.

It is not disputed that *Kara* discloses a system that displays shipping rates for a plurality of carriers and with which a consumer can select a particular carrier. However, it is respectfully asserted that the above-cited position by the Office Action fails to consider the combination of limitations claimed in one way or another by independent Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display, to a consumer of carriers [and services] according to a pre-selection by a merchant for subsequent use by the consumer for returning merchandise.

[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, (United States Patent and Trademark Office; *Official Gazette* Notices for November 22, 2005), § II.C (*citing Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) ("It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This

is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.")).

In view of the mandate by the *Interim Guidelines* to consider every limitation of a claim as a whole, it is respectfully asserted that *Kara*'s disclosure of shipping rates for a plurality of carriers comprises a static list of carriers. As compared to *Kara*'s static list of carriers, it is respectfully asserted that a display to a consumer by an exemplary embodiment of the combination of limitations of independent Claims 1, 27, 62, 65, 100, 103, 138, and 141 would list carriers according to a pre-selection or pre-identification of carriers by a merchant to whom the consumer wanted to return an item. That is, various embodiments of the combination of limitations of independent Claims 1, 27, 62, 65, 100, 103, 138, and 141 would allow a merchant to customize the list of carriers [and delivery services] that are later displayed to the merchant's customers that want to return merchandise to the merchant.

In rejecting, among others, Claim 27, the Office Action asserted, but did not further discuss reasons for relying on, *Siegel* and *Junger* with respect to the limitations claimed by Claim 27 regarding generating a display to a consumer of carriers [and services] that have been pre-selected by a merchant. *See Office Action*, Topic Nos. 8-10, pgs. 4-5.

It is respectfully asserted that various embodiments of the combination of limitations claimed by Claims 1, 27, 62, 65, 100, 103, 138, and 141 for displaying, or generating a display, to a consumer of carriers according to a pre-selection by a merchant for subsequent use by the consumer in shipping a return of an item to the merchant are distinguished from, and would be useful over, *Schwab*, *Siegel*, *Junger*, *Kara* and the other references of record, in that providing a Merchant with the ability to customize the list of available carriers [and delivery services] for customer shipping of returns would allow the Merchant control over return shipping quality and costs not provided by *Schwab*, *Siegel*, *Junger*, *Kara* and the other references of record. Accordingly, it is respectfully asserted that Claims 1, 27, 62, 65, 100, 103, 138, and 141 are in condition for allowance.

An Online Retail System's Display of Potentially Returnable Items Comprising Shipped Items Purchased Through the Online Retail System is Patentably Distinct From the References of Record that Appear to Require a Customer to Either Physically or Electronically, Address or Appear at a Site Other Than the Website Through Which the Customer Purchased the Item to be Returned

For the reasons described in more detail below, it is respectfully asserted that a particular online retail system's display of potentially returnable items comprising shipped items purchased through the particular online retail system as claimed by independent Claim 1 is patentably distinct from the references of record, including *Schwab*, *Siegel*, and *Junger* that appear to require a customer to either physically (in the cases of *Schwab* and *Junger*) or electronically (in the case of *Siegel*) turn to a physical location or website other than the website through which the customer purchased an item to be returned.

As distinguished from the references of record, it is respectfully asserted that various embodiments of the limitations of Claim 1 of the present application, for example, would allow a consumer to input a merchandise return request into the same online retail computer system through which the consumer had purchased the item to be returned. In particular, Claim 1 recites:

> receive through an online retail computer system of a particular online merchant, an indication of a shipment of an at least one item of merchandise purchased by a consumer through the online retail computer system;
> in response to the indication of shipment, designate through the online retail computer system, the at least one item as a potentially returnable item;
> receive through the online retail computer system a request by the consumer for an identification of potentially returnable items;
> in response to the request, generate a display through the online retail computer system to the consumer of the identification of potentially returnable items, wherein the identification of potentially returnable items comprises an identification of the at least one item of merchandise, and further comprises a respective interactive means associated with each respective item of merchandise identified in the identification of potentially returnable items, wherein each respective interactive means is adapted for designating a return of each respective item of merchandise identified in the identification of potentially returnable items ....

As compared to allowing a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system, it is respectfully asserted that *Schwab* discloses a consumer having to deliver the item and a document (a "ReturnCERT 501") to a local return agent. *See, e.g., Schwab*, Paragraph 0052.

As compared to the above-identified combination of limitations recited, for example, by Claim 1 of the present application, it is respectfully asserted that, according to *Siegel*, in order for a user of *Siegel* to view the *Siegel* listing of a particular purchase, the user would need to have previously made the purchase through another website, namely, through the website of an online merchant (*see, e.g., Siegel*, ¶0026 ("The server system adds transaction listing 101 and detailed item description 104 to each web page for the item(s) the user has purchased from various retailers."); *see also, e.g.,* FIG. 1A), and would then subsequently need to log in to the *Siegel* website, not the website from which the relevant purchase had been made, in order to view the *Siegel* listing of purchases made by the user from various retailers and in order to arrange for a return of the item. *See, e.g., Siegel*, ¶0008 ("the method preferably includes identifying a user, gathering a transaction history associated with the identified user and displaying the transaction history associated with the identified user").

The Office Action does not disagree, conceding that "Schwab and Siegal [sic] ... fails to disclose it being through the online retail computer system ...." However, in an effort to compensate for the conceded failures of *Schwab* and *Siegel*, the Office Action asserts that "Junger discloses the use of a return system at a local site, then this information is sent to a remote approval computer system for authorization of the return (Column 2, lines 46-67)." *Office Action*, Topic No. 5, p. 4. The Office Action then asserts that "... it would have been obvious ... to substitute one method for the other to achieve the predictably result of returning an item to a retailer." *Office Action*, Topic No. 5, p. 4 (citing the 2007 *KSR Int'l v. Teleflex* decision by the Supreme Court).

It is respectfully asserted that *Junger* does not add anything to the combination of references. *Junger* discloses, with reference to its FIG. 1, that "a regional warehouse 1 operated by a large retail chain collects product returns from local retail stores 3A and

3B." _Junger_, col. 3, lines 48-50. In _Junger_, "[a]fter the returned products arrive at the regional warehouse 1, they are sorted by manufacturer and/or product, and are shipped from the regional warehouse 1 to the manufacturer warehouse 5 for credit or replacement." _Junger_, col. 3, lines 61-64. According to _Junger_, "[e]ach step of the foregoing example return process involves various processing and handling requirements. For example, personnel at the local retail store must first review the product for compliance with applicable return requirements ... and then arrange for shipment to the appropriate regional warehouse ...." _Junger_, col. 4, lines 1-8. According to _Junger_, the _Junger_ system "... may be utilized ... in connection with operations at the retailer regional return center warehouse 1 ...." _Junger_, col. 4, lines 24-26.

That is, in _Junger_, like _Schwab_, the user must have already delivered the returned item to a physical return location, such as a local retail store. Accordingly, it is respectfully asserted that _Junger_ does not allow a consumer that had purchased an item of merchandise through a particular online retail computer system to input a merchandise return request into the same online retail computer system as claimed by amended independent Claim 1.

For the above-given reasons, because it is respectfully asserted that amended independent Claim 1 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 1, namely, Claims 2-21, are therefore also patentably distinct from the references of record.

Claimed Limitations Regarding a Display Through an Online Merchant's Retail Computer System of an Identification of Returnable Items Comprising Shipped Items that were Purchased by a Consumer Through the Online Merchant's Retail Computer System are Patentably Distinct From the References of Record that Appear to Generate a List of Returnable Items Based on Items That Were Purchased, but Not Necessarily Shipped

Even in view of the above-recited limitations of Claim 1, the Office Action asserts that even though _Schwab_ "... fails to disclose the use of a display, which displays each

item of a previous order and an interactive means associated with each item in each order, to return an item ...", the Office Action asserts that "Siegel discloses a return system where a user's previous orders along with each item in the order are displayed, and each item is associated with a checkbox, which the examiner considers to be an interactive means, to submit a return request ...." *Office Action*, Topic No. 4, p. 3 (citing Figure 1A of *Siegel* and the "corresponding detailed description").

It is respectfully asserted that none of the references of record, including *Schwab* and *Siegel*, whether considered alone or in combination, disclose, anticipate, teach or suggest the combination of limitations of independent Claim 1 for "...generat[ing in response to the request by the consumer for an identification of potentially returnable items] a display through the online retail computer system to the consumer of the identification of potentially returnable items, wherein the identification of potentially returnable items comprises an identification of the at least one item of merchandise [purchased by the consumer through the online retail computer system and shipped] ...".

The Office Action responds that "[n]o matter what the items are called, they are returned, so whether the items were first purchased or shipped, this was done outside of the system and method as claimed, and terms 'shipped' or 'purchased' are simply descriptive non-functional limitations used to describe what type of items are being used." *Office Action*, Topic No. 19, p. 7.

Applicants respectfully disagree. It is respectfully asserted, the reasons described further below, that the distinction between an item that has been purchased but not yet shipped, as compared to an item that has been purchased and shipped, is functional and relevant to the claimed subject matter.

Siegel discloses a system that gathers from various retailer systems/databases information about purchase transactions by a user. *See, e.g., Siegel*, ¶[0008] and ¶[0026]; *Siegel*, FIG. 2, element 215 ("Transaction Database"); *Siegel*, FIG. 5, element 535 ("Gather Transaction History for User"); *Siegel*, ¶0045. *Siegel* explains that the transactions are gathered from a collection of databases for multiple retailers and other sources. *Siegel*, ¶0045 ("... transactions database 215 can be maintained at another

location as well as created real-time from a collection of databases located at member retail sites, credit card sites or other data bases."); *see also, e.g., Siegel*, ¶0008 ("the method preferably includes identifying a user, gathering a transaction history associated with the identified user and displaying the transaction history associated with the identified user").

When a user accesses the *Siegel* system, the *Siegel* system would present a list of such purchase transactions by the user with various retailers. *See, e.g., Siegel,* ¶[0008] and ¶0026].

It is respectfully asserted that *Siegel* does not disclose differentiating between purchases that have been made but not yet shipped, and items that have been purchased and shipped to the user. Therefore, it is respectfully asserted that a *Siegel* listing for a particular user may contain both items that have been purchased but not yet shipped, as well as items that have been purchased and shipped to the user. A user of *Siegel*, therefore, would be presented with a display that may include items that have not yet been shipped to the user and therefore would not yet have been received by the user. It is respectfully asserted that a user of a *Siegel* display of a listing of an item that has not yet been shipped could incorrectly select such an item for return.

In order to discuss the types of issues that could result from such an incorrect selection, it may be helpful to consider a period of time during which a user may be involved in a relatively high number of purchases, such as, for example, during Christmas. During high transaction activity periods, a user may make repeated purchase of a same or similar item. A user may receive one such item and want to return it. However, the corresponding *Siegel* display would list the item that the user had already received as well as other item(s) of the same or similar type that the user had purchased but had not yet been received, or that, perhaps, had been shipped to others. Presented with such a list that co-mingles both shipped and not-yet-shipped items, the *Siegel* user may indicate return of an item that was not yet been shipped by mistake. It is respectfully asserted that, for items that may have a perishable life, such an erroneous "return" could result in improper return processing by the merchant.

As distinguished from _Siegel_, Claim 1 claims designating items that have been shipped, not merely purchased, as potentially returnable items. It is respectfully asserted that various embodiments of the limitations of Claim 1 would be useful over the _Siegel_ system in that only shipped items would be listed as potentially returnable, thereby preventing possibly confusing listings of items purchased but not yet shipped as potentially returnable, as would be possible under _Siegel_.

For the above-given reasons, because it is respectfully asserted that independent Claim 1 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 1, namely, Claims 2-21, are therefore also patentably distinct from the references of record.

Identifying at Least One Item as an Exception to Standard Return Policy Rules is Patentably Distinct From the References of Record

It is respectfully asserted that the limitations of independent Claim 100 are patentably distinct from the references of record. In particular, Claim 100 recites:

> generating a graphic user interface for input of return policy rules, wherein the graphic user interface is adapted for receiving input identifying an item as an exception to standard return policy rules;
> collecting a set of return policy rules input by a merchant using the graphic user interface, wherein the set of return policy rules comprises an identification of at least one item as a policy rule exception, and wherein the set of return policy rules further comprises an identification by the merchant of a set of carriers and delivery services offered by each carrier of the set of carriers for selection by a consumer to ship a return of merchandise ....

It is respectfully asserted that the provision by various embodiments of the above-mentioned limitations of Claim 100 would be useful over the references of record in that the claimed exception definition and processing would provide a merchant with the ability to establish general return rules for broad categories of merchandise and designate certain items as exceptions to the general return rules.

Yet further, it is respectfully asserted that neither _Schwab_, nor any of the other references of record, disclose, anticipate, teach or suggest the recitation of Claim 100 of the limitation for "...generating a graphic user interface for input of return policy rules,

wherein the graphic user interface is adapted for receiving input identifying an item as an exception to standard return policy rules...".

For the above-given reasons, because it is respectfully asserted that amended independent Claim 100 is patentably distinct from the references of record, it is respectfully asserted that the Claims that are dependent on Claim 100, namely, Claims 101-102, are therefore also patentably distinct from the references of record.

Return Policy Rules Comprising a Set of Return Questions are Patentably Distinct From the References of Record

Further still, it is respectfully asserted that neither *Schwab*, nor any of the other cited references, disclose, anticipate, teach or suggest the recitation by e.g., Claims 61 and 65, of the limitation "... wherein [a sub]set of [the] return policy rules [input by the merchant] comprises: a set of return questions; and a set of anticipated return question responses corresponding to each of said return questions...". It is further respectfully asserted that the Office Action fails to cite any references that disclose the above-cited limitations of Claims 61 and 65.

For the above-given reasons, it is respectfully asserted that Claims 61 and 65 are patentably distinct from the references of record and are therefore in condition for allowance.

Generating a Credit to a Credit Card Account in Response to a Return Request is Patentably Distinct From the References of Record

Further still, it is respectfully asserted that neither *Schwab*, nor any of the other cited references, disclose, anticipate, teach or suggest the recitation by Claim 60 of the limitation "...in response to receiving the indication of receipt by the merchant of the item of merchandise, generate a credit to the credit card account." It is further respectfully asserted that the Office Action fails to cite any references that disclose the above-cited limitations of Claim 60.

For the above-given reasons, because it is respectfully asserted that Claim 60 is therefore patentably distinct from the references of record, it is respectfully asserted that

the Claim that is dependent on Claim 60, namely, Claim 61, is therefore also patentably distinct from the references of record.

Generating a Display of an Interactive Graphic Comparison of Calculated Shipping Rates at the Intersection of Corresponding Delivery Dates and Times is Patentably Distinct From the References of Record

It is respectfully asserted that the combination of limitations recited by amended dependent Claim 15 (and the Claims on which it depends) is patentably distinct from the references of record. In particular, amended dependent Claim 15 (and the Claims on which it depends) claims the generation of a display to a consumer of calculated shipping rates for carriers pre-identified by a merchant such that the rates are displayed at an intersection that coincides with a particular delivery date and a particular delivery time by which a particular delivery service by a particular carrier would deliver an item being returned by the consumer to a particular online merchant for the displayed shipping rate.

The Office Action concedes that *Kara* does not specifically disclose the rates being calculated with respect to time, but asserts that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day." *Office Action*, Topic No. 12, p. 5. The Office Action further asserts that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive "urgency" services, as disclosed by FedEx® and UPS® , in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1)." *Office Action*, Topic No. 12, p. 5.

The Office Action further concedes that "Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services, where one axis being date and one axis being time and where each cell is located at the intersection of the date and time." *Office Action*, Topic No. 12, p. 5. The Office Action then asserts, though, that "Barnet [sic] discloses the use of a calendar which can be [used] for online purchasing of services (column 2, lines 63-67), where there is a

graphical representation of date on one axis and time on another (See Figure 9)."
Office Action, Topic No. 12, pgs. 5-6. The Office Action concludes that "[i]t would have
been obvious ... to display the calculation of shipping rates, calculated by Kara, UPS®
and FedEx®, in the format of a plurality of cells with date on one axis and time on
another, as disclosed by Barnett, in order to provide a multi-layers system wherein
different categories can be overlaid on one another providing a single integrated display
that allows a user to order or purchase a system based on the calendar day and time
(See Barnett, column 2)." *Office Action*, Topic No. 12, p. 6.

It is respectfully asserted that instead of contributing to the claimed limitations
recited by Claim 15, the *UPS* and *FedEx* references depict the problem that a user
would face in trying to obtain comparison of shipping rates and delivery times and dates
across multiple carriers and multiple delivery services offered by those carriers.

A user of *FedEx* would encounter the description of *FedEx* that different delivery
times apply depending on the shipping particulars for shipping a particular parcel. For
example, *FedEx* explains that "FedEx Priority Overnight®" is for providing "...delivery by
10:30 a.m. the next business day to thousands of U.S. cities in our primary service are
(noon to most of the rest)." *FedEx*, p. 1.

That is, in order for a *FedEx* user to determine whether a parcel to be shipped
using FedEx Priority Overnight® would result in delivery by 10:30 a.m. the next
business day, or by noon the next business day (or some other time) the user would
need to investigate whether the city to which the parcel was to be shipped was one of
the "thousands" for which delivery would be provided by 10:30 a.m., or whether the city
was one of the "most of the rest" for which delivery would be provided by noon, or
whether the city was neither one of the "thousands" for which delivery would be
provided by 10:30 a.m., or one of the "most of the rest" for which delivery would be
provided by noon, in which case, the FedEx reference provides no indication of a
delivery time guarantee. Moreover, whatever the result of the user's above-outlined
investigation, the time for delivery determined by the user would apply only if the user
elected to use the FedEx Priority Overnight® delivery service; the user would need to

plod on with further investigation to determine a comparison of a delivery time if the user were to instead, for example, elect FedEx Standard Overnight® or FedEx 2Day(SM).

The above-described steps that a *FedEx* user would have to take to determine the delivery time of a parcel to be shipped for any particular FedEx® service are evidence that *FedEx* does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Trying to obtain a comparison of projected delivery dates would also have required the *FedEx* user to investigate the specific FedEx® rules as those rules pertained to the user's particular shipping requirements. That is, the information provided in *FedEx* is only general information.

Regarding a date by which delivery would be expected, *FedEx* explains that Saturday delivery is not available for the "FedEx Standard Overnight®" service. *FedEx*, p. 1. That is, if a parcel is shipped on a Friday using FedEx Standard Overnight®, because delivery on Saturday is not available for that service, the parcel would not be delivered until the following Monday, or if the following Monday were a holiday, by the following Tuesday. Therefore, in order for a delivery *date* to be determined, a user of *FedEx* would need to consult a calendar (mentally or visually) to determine the delivery date on which a parcel shipped via, e.g., FedEx Standard Overnight® should be delivered. For example, if the user was shipping a package on, *e.g.,* a Friday, the user would need to identify the date of the following Monday, or if the following Monday were a holiday, the following Tuesday.

Yet further, in order for a delivery date to be determined, a user of *FedEx*, may, depending on the circumstances, need to consult a clock to determine the date of expected delivery of a parcel to be sent by FedEx Standard Overnight®. For example, if the user was shipping the package after a particular cut-off time, the package may not be delivered the following day -- that is, the package may be delivered two days after the shipment date.

The above-described steps that a *FedEx* user would have to take to determine a delivery date of a parcel to be shipped, *e.g.,* using FedEx Standard Overnight® are

further evidence that _FedEx_ does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Further still, if a user of _FedEx_ wanted to compare, across various FedEx® services, delivery dates and times of a particular parcel that the user wanted to ship, the user would need to determine a delivery date and time for each FedEx® service to be compared. The aforementioned steps that a _FedEx_ user would have to take to determine a cross-comparison with an indication of delivery dates and times for a parcel using only a single carrier, _e.g.,_ FedEx®, is yet further evidence that _FedEx_ does not disclose the combination of limitations recited by Claims 15 (and the Claims on which Claim 15 depends).

Turning to the _UPS_ reference, as with _FedEx_, _UPS_ teaches that, even for "guaranteed" services (_See, e.g., Office Action_, Topic 12, p. 5 (stating that "[b]oth UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day.), different delivery times may apply depending on the shipping and/or delivery particulars for shipping and delivering a particular parcel. For example, for the UPS Next Day Air Early A.M.® delivery service, even though _UPS_ states "Guaranteed Overnight by 8 A.M.", _UPS_ clarifies that "[y]ou get guaranteed delivery by 8:00 a.m. to major U.S. cities and by 8:30 a.m. to _most_ other U.S. cities (9:00 a.m. or 9:30 a.m. on Saturday)..." (emphasis added). That is, in order for delivery to be "Guaranteed Overnight by 8 A.M.", assuming the delivery was to occur Monday through Friday, the delivery address would need to be in one of the "major U.S. cities;" in order for delivery to be guaranteed by 8:30 a.m., the delivery address, if not in one of the "major U.S. cities", would need to be in one of the "_most_ other U.S. cities..." (emphasis added).

As another example of guarantee-dependency on shipping particulars, for the UPS Next Day Air® delivery service, even though _UPS_ states "Guaranteed Overnight by 10:30 AM", _UPS_ clarifies that delivery is guaranteed "...by 10:30 a.m., noon, or end-of-day the next business day _depending on destination_ (noon or 1:30 p.m. on Saturdays)." (emphasis added). That is, according to _UPS_, delivery time would be dependent on the destination address and the day of the week shipped.

Further, the _UPS_ reference teaches that, notwithstanding the name of a delivery service, delivery guarantees may depend on the day of the week on which shipping occurs. For example, some UPS® delivery services support Saturday delivery; whereas others do not; Sunday delivery options are not indicated in _UPS_ for any of the UPS® delivery services. _Compare, e.g., UPS_, p. 2 (describing, for UPS Next Day Air Early A.M.®, both a Saturday Delivery option and a Saturday Pickup option) and _UPS_, p. 4 (describing, for UPS Next Day Air®, both a Saturday Delivery option and a Saturday Pickup option), _with UPS_, p. 6 (describing, for UPS® 2nd Day Air A.M.®, a Saturday Pickup option, but with no mention of a Saturday Delivery option).

That is, assuming that the delivery address is to one of "most metropolitan addresses" to which delivery would be "Guaranteed Two-Day by 12 Noon" (_see, UPS_, p. 6), if a package were sent on a Thursday via UPS® 2nd Day Air A.M.®, even though the delivery service name "UPS® 2nd Day Air A.M.®" may imply that the delivery would be made by the second day, a Saturday, following the Thursday shipment day, according to _UPS_, Saturday delivery would not be available. Because a Saturday delivery option is not available for the "UPS® 2nd Day Air A.M.®" delivery service, then delivery for a package sent on a Thursday using the "UPS® 2nd Day Air A.M.®" delivery service would not be available until the next day available for deliveries for the "UPS® 2nd Day Air A.M.®" delivery service -- which, because neither Saturday nor Sunday are indicated in _UPS_ as delivery days for the "UPS® 2nd Day Air A.M.®" delivery service, would therefore not occur until, _e.g._, the following Monday, or if the following Monday were a holiday, then possibly not until the following Tuesday.

The above-described variations in delivery days and times for various UPS® delivery services as dependent on specific shipping and/or delivery parameters is evidence that the mere listing of a delivery service by name, and/or a general statement of guarantee, are not a conclusive indication of a delivery date or time for a particular parcel to be shipped to a particular address.

The _UPS_ reference shows a "Quick Cost Calculator" link on each separate UPS® delivery service website page. For example, for the UPS Next Day Air Early A.M.® delivery service, _UPS_ states "Use the Quick Cost Calculator to determine shipping

rates, availability and delivery times for UPS Next Day Air Early A.M." *UPS*, p. 2. As another example, for the UPS Next Day Air® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Next Day Air." *UPS*, p. 4. As a further example, for the UPS 2nd Day Air A.M.® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air A.M." *UPS*, p. 6. Yet further, for the UPS 2nd Day Air® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 2nd Day Air." *UPS*, p. 8. For the UPS 3 Day Select® delivery service, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS 3 Day Select." *UPS*, p. 10. For UPS Ground, *UPS* states "Use the Quick Cost Calculator to determine shipping rates, availability and delivery times for UPS Ground Service." *UPS*, p. 12.

It is respectfully submitted that, even once a *UPS* user had obtained a set of rates and delivery dates and times for various delivery services offered by UPS®, doing so would not have provided the *UPS* user with rates and delivery dates and times, for various delivery services offered by any other carrier.

Further still, it is respectfully asserted that *Kara* does not compensate for the elements missing from the other cited references. As compared to the combination of limitations claimed by Claim 15 (and the Claims on which it depends), *Kara* discloses a system that requires that a user first pre-select a class and/or delivery "urgency". FIG. 7 of *Kara* depicts process element 712 that is labeled "Class/Urgency" and that contains the description "Select from different choices: first, third, fourth, bulk rate, priority mail, air mail, same day, overnight, next day, 2 days, 3 days". FIG. 8 of *Kara* depicts a display interface with a box 802 providing fields for Weight (Pounds and Ounces), Zone, Class, and a choice of Domestic or International. FIG. 8 of *Kara* also depicts a box 807, labeled as "Urgency" and containing the choices of "Same day", "Overnight", "Next day", "2 Days", "3 Days", and "Immaterial". The specification of *Kara* explains that, "[i]n step 712, the user selects the class and/or urgency of the item from the choices shown in box 802 and 807. It shall be appreciated that ones of the selections of class and

urgency may substantially overlap and, therefore, selection of such an option from one of boxes 802 or 807 may also make a corresponding selection in the other one of boxes 802 or 807." *Kara*, col. 21, lines 1-7.

Kara discloses that "class and urgency information may be different for each of the shipping service providers and, accordingly, selection of a particular class[ ] or urgency criteria may be based at least in part on the particular shipping service provider(s) for which the user wishes the ... program to calculate the necessary postage.... Alternatively, the class and urgency information may be presented for selection generically, as shown in FIG. 8, and the ... program operate to determine the corresponding fees for each of the particular shipping service providers automatically." *Kara*, col. 21, lines 8-20.

Whether the class and urgency information available for selection by the user is presented "generically" (as depicted in FIG. 8 of *Kara*), or is available for "selection ... based ... on the particular shipping service provider", *Kara* explains that, only after a selection of class and/or urgency is made are fees calculated and displayed.

> In order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship the piece of mail or other item, the E-STAMP program may calculate the fees associated with a plurality of the available shipping service providers. Accordingly, the user may select shipping service providers of interest (not shown) in order to allow the E-STAMP program to determine the fees for only those shipping service providers. Thereafter, the E-STAMP program may calculate and display fees associated with shipping the item via the selected shipping service providers according to the desired shipping and/or delivery parameters, i.e., class, urgency, etc. Where a selected shipping service provider does not provide a desired shipping and/or delivery parameter, the E-STAMP program may indicate such and provide the fees for a service offered by that particular shipping service provider most near that desired by the user.

> However, in the preferred embodiment, the E-STAMP program automatically calculates the fees for each shipping service provider offering service commensurate with the desired shipping and/or delivery parameters. Additionally, the E-STAMP program may indicate other ones of the shipping service providers which do not provide a desired shipping and/or delivery parameter and provide the fees for a service offered by that particular shipping service provider most near that desired by the user, as well as indicate how their service differs from that desired.

Kara, col. 22, lines 20 – 48.

FIG. 8 of *Kara* depicts box 808 which is labeled "Selection & Comparison". In box 808 of FIG. 8 of *Kara*, the carriers "US Post", "Federal Express", "DHL", "UPS", "Purolator", and "Emery" are listed. To the left of each carrier is a box, with which to select one of the carriers. *See Kara*, col. 22, lines 53-54 ("...the user selects a particular shipping service provider, such as by checking a box associated therewith (shown in box 808) ..."). To the right of each carrier (shipping service provider) in box 808 is a dollar field for display of a shipping rate. *Kara*, FIG. 8. Importantly, only one dollar field is indicated per carrier.

Yet further, it is respectfully submitted that *Barnett* does not disclose any display of rates by the *Barnett* system.

The subject matter of *Barnett* is calendaring, not rates. More specifically, *Barnett* discloses a "... computer-implemented method and system for generating and displaying a calendar containing user-selected events from user-selected categories." *Barnett*, Abstract. Figure 9 of *Barnett* displays a user-customized week-view calendar of events. According to the disclosure of *Barnett*, the week-view calendar of events reflects a user's selection of categories of events. *See Barnett*, FIG. 9; *Barnett*, col. 12, lines 16-21. Figure 8 of *Barnett* shows a month-view of a user-customized calendar. *See Barnett*, FIG. 8; *Barnett*, col. 11, lines 36-38. Figure 10 of *Barnett* shows a day view. *See Barnett*, FIG. 10; *Barnett*, col. 12, lines 42-43. None of the various calendars depicted in *Barnett* depict any display of rates. Moreover, there is simply no disclosure in any of the Figures of *Barnett*, or in the disclosure of *Barnett*, that prices for the various calendared events are displayed in any of the *Barnett* calendars or schedules.

It is true that *Barnett* discloses that "[o]nline purchasing and related actions can be associated with each event" (*Barnett*, Abstract). However, *Barnett* explains that the referred-to purchases would be done using links. *See, e.g., Barnett*, col. 2, lines 65-67 ("In addition, purchases of products, services, or tickets can be effected using links associated with displayed events."); *see also, e.g., Barnett*, col. 14, lines 13-17 ("In another embodiment, a link may be provided for making a purchase associated with a particular event. For example, if the event is a concert, a link to an on-line ticketing

service maybe provided, for purchasing tickets to the concert."). It is respectfully submitted that the absence from the disclosure of *Barnett* of a display of price for a calendared event, and the disclosure of *Barnett* that a link to a separate service may be provided for making a purchase associated with a calendared event are evidence that *Barnett* did not contemplate that the system of *Barnett* would itself associate a price with an event calendared by the *Barnett* system.

Further, even assuming for the sake of argument that it could be argued that *Barnett* somehow suggested showing rates, it is respectfully asserted that the rates that *Barnett* might display would be for the various events calendared, not as a cross-comparison of rates for a single event such as the single event of a shipment of a return item to which Claim 15 (and the Claims on which Claim 15 depends) are directed.

Yet further, as compared to the limitations recited by Claim 15, it is respectfully asserted that FIG. 9 of *Barnett* discloses a display of an identification of a pre-scheduled event at an intersection that coincides with a pre-scheduled date and time for the particular event. That is, *Barnett* does not determine a schedule for an event. Rather, the events that are displayed by *Barnett* have already been pre-scheduled.

As distinguished from the display of pre-scheduled events in *Barnett*, it is respectfully asserted that an exemplary embodiment of the limitations of Claim 15 would result in a customized display of rates that would be calculated and displayed on a schedule of delivery dates and delivery times that would be determined relevant to a particular shipping date, according to the parameters of the particular item being returned, and according to pricing rules for the particular carriers that had been pre-selected by a merchant.

For the above-given reasons, it is respectfully submitted that even assuming for the sake of argument only, that *Barnett* discloses rates, the combination of *Kara*, *Barnett*, *UPS* and *FedEx* would not result in the combination of limitations recited by Claim 15 (and the Claims on which it depends). Accordingly, it is respectfully asserted that Claim 15, and the Claims that depend on Claim 15, namely, Claims 16-21, are therefore patentably distinct from the combination of *Barnett* with *UPS*, *FedEx* and *Kara*

(and for the reasons described above for Claim 1, from *Schwab*, *Seigel* and *Junger*), and are in condition for allowance.

CONCLUSION

For the above-given reasons and for the authorities cited above, it is respectfully asserted that none of *Schwab*, *Siegel*, *Kara*, *Junger*, *UPS*, *FedEx*, *Barnett*, or any other reference of record, whether considered alone or in combination, disclose, anticipate, teach or suggest all of the limitations of the amended Claims.

Therefore, in view of the foregoing amendments, and for the foregoing reasons, it is respectfully asserted that the invention disclosed and claimed in the present application as amended is not fairly taught by any of the references of record, taken either alone or in combination and that the application is in condition for allowance. Accordingly, it is respectfully requested that the present application be reconsidered and allowed.

Respectfully submitted,

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